

REMARKS

Claims 68-119, 122-127, 129, and 132-137 are pending in the subject application. Claim 68 is amended and claim 75 is canceled herein. Applicants submit that the amendments introduce no new matter, support therefore being found throughout the application and drawings as originally filed. Favorable reconsideration in light of the amendments and remarks which follow is respectfully requested.

1. Specification

As noted in the Advisory Action, the objections to the specification have been withdrawn.

2. 35 U.S.C. §103 Rejections

Weiner and Rosenman

Claims 68-91, 93-97, 99-109, 111-119, 122-127, 129, and 132-138 are rejected under 35 U.S.C. §103(a) over U.S. Patent No. 5,466,233 to Weiner et al. ("Weiner") and U.S. Patent No. 6,478,776 to Rosenman et al. ("Rosenman").

The Office asserts that it would be obvious to modify Weiner's tack to provide the entire post 12 with a coil or zig-zag shape so that the device can be properly positioned and maintained in the desired location. Applicants disagree.

Applicants teach coil-shaped or zig-zag shaped body members which have been found to solve problems with prior ocular implants. In particular, prior ocular implants are limited in the amount of drug that can be housed within them and, thus, delivered to the eye because (1) if the implant is made longer to accommodate a larger quantity of drug, it obstructs vision and (2) if the implant is made wider to accommodate a larger quantity of drug, the implant becomes more uncomfortable in the eye and the incision through which the implant must be inserted becomes undesirably larger. Applicants' implants are capable of holding a greater volume of drug/agent per unit length of the device without requiring an increase in the length of the device or the width/cross-section (and, thus, the size of insertion). While Applicants note that the coil and zig-

zag shapes can aid in preventing unwanted ejection of the device from the eye (because the device must be twisted out of the eye), the body member which reside within the vitreous (and, thus, fluid) of the eye is not described by Applicant as providing stability or an anchoring region within the vitreous.

Weiner is also directed to ocular implants. According to Weiner, a tack 10 is provided with a central region 14 and a post 12. The central region 14 is either an anchoring region (e.g. by the use of protrusions shown as 14a in FIGS. 1-4) or a region for ease of removal (e.g. by the use of a straight/linear walled section shown as 14b in FIGS. 8-12). As such, according to Weiner the central portion 14 has a length “e” that corresponds to the combined thickness of the solid tissues of the eye – the retina, choroid, and sclera (see col. 5, lines 29-34).

Nothing in Weiner teaches or suggests that the post 12 – which is a separate element from central region 14 – could somehow be used to anchor the tack in the eye. The post 12 resides completely in fluid and, thus, there is absolutely no teaching or suggestion by Weiner that the post 12 could be somehow capable of holding the tack in place. The teaching of Weiner is only that (1) the central region 14 which reside completely in the solid tissue of the eye, and/or (2) the head 16 which is in contact with the outer solid surface of the eye, are capable of stabilizing or anchoring the tack.

Rosenman describes an implant that is entirely surrounded/buried within solid tissues of the heart. As such, Rosenman describes implant configurations wherein any portion of the implant can provide stabilization in the surrounding solid tissue. There is absolutely no teaching or suggestion by Rosenman with respect to stabilization of a device in a material that is mainly fluid, with solid tissue only at the outer surface and fluid below the outer surface.

In sum, there is no teaching, suggestion, or motivation by either Rosenman or Weiner or any other cited documents that an ocular implant could or should be designed with a coil or zig-zag shape along it’s entire body length (which resides in fluid). Further the Office has not provided any teaching, suggestion, or motivation by either Weiner or Rosenman to design a body

member that resides within fluid so as to be in a coil or zig-zag shape along its entire length. Weiner only suggests that a head (residing on the outer surface of the eye) and a central portion (which resides only in the retina, choroid, and sclera) can provide anchoring. Rosenman only suggests that the portions residing within solid tissue can provide anchoring. Thus, the Office's assertion that it is somehow obvious to design a body which resides in fluid in a coil shape to somehow provide anchoring relies completely on hindsight reasoning and is improper.

Accordingly, claims 68, 79, 83, 93, 99, 111, 116, and 129, and all claims dependent therefrom, are patentable over Weiner and Rosenman. Reconsideration and withdrawal of the rejections is respectfully requested.

Weiner and Rosenman and Johnson

Claims 92, 98, and 110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiner, Rosenman, and U.S. Patent No. 5,972,027 to Johnson ("Johnson"). Applicants respectfully traverse.

As set forth above, Weiner and Roesnman fail to teach or suggest Applicants' devices or methods as recited in independent claims 83, 93, and 99. Johnson is cited for allegedly describing shape memory materials. However, Johnson does not remedy the above-noted deficiencies in Weiner and Rosenman.

Accordingly, claims 92, 98, and 110 (which depend from claims 83, 93, and 99) are patentable over Weiner, Rosenman, and Johnson. Reconsideration and withdrawal of the rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Varner at al.
Application No.: 10/740,698
Page 16 of 16

If for any reason the fee paid is inadequate or credit is owed for any excess fee paid, the Office is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Date: June 22, 2010

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